SUPREME COURT, U. S.

FILED
MAY 25

IN THE

Supreme Court of the United States

OCTOBER TERM, 1971

No. 71-1354

WESTINGHOUSE ELECTRIC CORP., *Petitioner,*

v.

TITANIUM METALS CORP. OF AMERICA, *Respondent.*

PETITIONER'S REPLY BRIEF

EDWARD F. McKIE, JR.
HAROLD J. BIRCH
WILLIAM E. SCHUYLER, JR.
Schuyler, Birch, Swindler,
McKie & Beckett
One Thousand Connecticut
Avenue, N.W.
Washington, D. C. 20036
Attorneys for Petitioner

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

INDEX

	Page
Petitioner Poses a Question to the Court Based Upon the Keystone of the Opinion Below; Nothing Has Been Taken Out of Context	1
Respondent Contradicts the District Court Finding of Lack of Prior Art Suggestion of Direct Remelting of Ingots	4
The District Court Findings Do Not State That the "828" Process (or Any Other Prior Art) Relied On Is More Pertinent Than the Prior Art Before the CCPA; Respondent's Brief Asserts That Prior Art Considered by the CCPA Was More Pertinent Than That Considered by the Courts Below	4
Respondent's "Further Reason" That the Opinion of the Majority Below Assertedly Was Correct Is Based on an Erroneous View of the Law by the District Court	6
The Newly Asserted Defense of Anticipation, Not Previously Made to the District Court, Cannot Support Its Conclusion of Obviousness	8
Conclusion	9

TABLE OF CASES CITED

Guiberson Corp. v. Equipment Engineers, Inc., 252 F.2d 431, 433 (5th Cir. 1958)	6
Hobbs v. United States, — F.2d —, 171 USPQ 713, 723 (5th Cir. 1971)	5
LaSalle Street Press, Inc. v. McCormick & Henderson, Inc., 445 F.2d 84, 93 (7th Cir. 1971)	5
Power Curbers, Inc. v. E. D. Etnyre & Co., 298 F.2d 484, 493 (4th Cir. 1961)	5
Preformed Line Products Co. v. Fanner Mfg. Co., 328 F.2d 265, 271 (6th Cir. 1964)	5
Russell v. Seeburg Corp., 123 F.2d 509, 512 (7th Cir. 1941)	7

IN THE

Supreme Court of the United States

OCTOBER TERM, 1971

No. 71-1354

WESTINGHOUSE ELECTRIC CORP., *Petitioner,*

v.

TITANIUM METALS CORP. OF AMERICA, *Respondent.*

PETITIONER'S REPLY BRIEF

Petitioner Poses a Question to the Court Based Upon the Keystone of the Opinion Below: Nothing Has Been Taken out of Context

Contrary to respondent's assertion that petitioner has taken selected words out of context, the "obvious to try" standard was the very reason given for the conclusion of obviousness by the majority below.

For the convenience of the Court, three short paragraphs stating the sole basis of the majority's conclu-

sion of obviousness is repeated here, italicized to indicate the source of the question presented:

> "The novel feature of the process step is exceedingly limited. It does not consist of the development of an additional technique, but the elimination from the prior art process of one of the features of that process, i.e., intermediate forging, rolling or fabrication. Even the elimination of this technique has some recognition in the prior art, as shown by finding of fact No. 14, describing nonconsumable arc remelting of arc-melted refractory metal fifty gram buttons without intermediate forging or rolling.*

The district court was warranted in concluding that where intermediate fabrication *thought necessary to* attain the desired quality of zirconium alloy, was time-consuming and contaminating, it would be *apparent* to those having ordinary skill in the art that *elimination* of the intermediate fabrication *should be tried* to see if it was really necessary. That is essentially all that happened in developing the process step described in the patent. Generally speaking, substantially less creative thought is involved in this kind of experimentation than in innovating an additional technique to be tacked onto the prior art process.

This is not to say that there cannot be invention absent a stroke of inventive genius. It may, in fact, be the fruit of an accident or serendipity. But whether it was obvious nevertheless depends in part upon the degree of creativity one having

---

* This statement ignores finding No. 15 that button remelting could not achieve the required homogeneity *without intermediate fabrication* and was limited to one half pound "buttons". In stating that the finding somehow suggests elimination of intermediate fabrication in ingot remelting, the majority perforcibly ignores finding No. 16, which expressly finds no such suggestion in the prior art.

> ordinary skill in the art would need to exercise in arriving at the same new idea without the help of an accident or unintended emergence of that idea. Having in view the specialized character of the art here in question, the level of ordinary skill in that art was relatively high. This means that what might not have been obvious to one having a lower level of skill *should have been obvious* to those who were active in this particular art."

The question presented in the Petition fairly reflects the basis of the decision below. That was the use of an *obvious to try* standard to justify a conclusion of obviousness of elimination of a step which the experts* thought was necessary to achieve the very purpose of the process. The Court could not otherwise justify a conclusion of obviousness of elimination of a step thought necessary by all concerned.

Respondent does not seek to defend the "obvious to try" standard. Tacitly it admits that the CCPA has rejected that standard in the line of decisions identified in the Petition (pp. 9-10).

Rather than resolve the conflict, respondent argues that a determination that it would be "apparent" that something "should be tried" is somehow different from "obvious to try". Of course, they are the same. The conflict is clear and should be resolved by this Court.

---

* Respondent's argument (R. Br. 10-12) that the majority below was correct in assuming a relatively high level of skill for the man of *ordinary* skill does not require response. The majority also assumed that the step in question was "thought necessary" (footnote 1, Petn. 2a). Presumably that thought would be in the mind of the man of ordinary skill, as it was in that of the expert. No matter how skilled he was, the man of ordinary skill thought the step necessary. How can its elimination properly be said to be obvious? Whether or not it *should* have been, it was not.

Respondent Contradicts the District Court Finding of Lack of Prior Art Suggestion of Direct Remelting of Ingots

In seeking to distinguish this case from the CCPA decisions rejecting the "obvious to try" standard, respondent blandly asserts (R. Br. 7) that double melting without intermediate fabrication was known prior to the invention of the patent in suit. The impression is thereby created that direct remelting of ingots is suggested by the prior art.

That impression directly contradicts the District Court's finding No. 16:

> "The published prior art prior to the alleged invention of the patent in suit contains *no suggestion* of direct consumable arc remelting of ingots of metal." (Petn. 14a)*

That finding, previously unchallenged by respondent, is controlling here.

The District Court Fndings Do Not State That the "828" Process (or Any Other Prior Art) Relied on Is More Pertinent Than the Prior Art Before the CCPA; Respondent's Brief Asserts That Prior Art Considered by the CCPA Was More Pertinent Than That Considered by the Courts Below

Seeking to avoid the conflict between the decision below and the CCPA decision holding the process in suit to be unobvious, respondent tries to create the erroneous impression that the District Court found that the basis of its decision (the "828" process) was more pertinent than the prior art considered by the Patent Office and the CCPA. There is no such finding.

The District Court merely stated:

> "Allowance of the patent in suit by the Patent Office without knowledge and consideration of the

* Unless otherwise indicated, emphasis is supplied.

> facts regarding the Bureau of Mines' '828' process, and without knowledge or consideration of the published prior art referred to in findings 14, 15, 16, 17 and 18, supra, deprives the patent of any presumption of validity with respect thereto." (Conc. E, Petn. 33a).

The decisions of the Courts of Appeals establish that the presumption is strengthened, not vitiated, when the newly cited prior art is no more pertinent than that considered by the Patent Office. *Hobbs* v. *United States*, — F.2d —, 171 USPQ 713, 723 (5th Cir. 1971); *LaSalle Street Press, Inc.* v. *McCormick & Henderson, Inc.*, 445 F.2d 84, 93 (7th Cir. 1971); *Power Curbers, Inc.* v. *E. D. Etnyre & Co.*, 298 F.2d 484, 493 (4th Cir. 1961).

The Sixth Circuit in *Preformed Line Products Co.* v. *Fanner Mfg. Co.*, 328 F.2d 265, 271 (6th Cir. 1964) expressly recognized that the fact of greater relevancy must be found, and that the burden is on the *defendant* to show it.

The District Court made no finding that the "828" process on which invalidity was predicated was more relevant than the Herres and Davis patent considered by the CCPA, which discloses remelting without intermediate fabrication and is, therefore, more pertinent than "828".

Respondent relies upon a disclosure in an article co-authored by *Davis, Herres* and *Greenidge* (R. Br. 5, 14, fn. 5) as a new basis for holding petitioner's patent invalid. The disclosure is the *same* as that described in the very *Herres* and *Davis* patent considered by the CCPA, as the authorship suggests. Both the article and the patent disclose melting a combination of powder and a previously melted ingot, without intermediate fabrication of the ingot. Neither discloses

any improvement in properties due to remelting. These are the two distinctions respondent acknowledges the CCPA found in its decision of unobviousness (R. Br. 10). Thus, respondent, at this stage, injects a new issue and advocates a decision in direct conflict with the decision of the CCPA.

If the new citation is *less* pertinent than, or even of the same pertinency as the prior art relied on by the majority below, why was it cited here? Obviously, respondent is asserting that the disclosure is *more* pertinent. Since the *same* disclosure was considered by the CCPA in deciding unobviousness of the invention in issue, in view of the Herres and Davis patent, it follows that the art considered by that Court is more pertinent than the art relied upon below to support a conclusion of obviousness.

That the patent in suit was issued on the basis of a determination of unobviousness by the CCPA should strengthen the presumption of validity. *Guiberson Corp.* v. *Equipment Engineers, Inc.*, 252 F.2d 431, 433 (5th Cir. 1958). Mere reliance on different (and less pertinent) prior art does not justify the contrary result.

The conflict between the CCPA and the majority below should be resolved.

Respondent's "Further Reason" That the Opinion of the Majority Below Assertedly Was Correct Is Based on an Erroneous View of the Law by the District Court

Respondent finds it necessary to argue that the majority's decision below was correct for a reason expressly not considered by the majority (Petn. 6a) but considered and rejected in the dissent (Petn. 9a). That was the assertedly independent practically con-

temporaneous invention of the process in issue by the Bureau of Mines. As pointed out in the appeal to the Court below, the very language of the finding adopted by the District Court shows a basic error of law in this regard. The Court erroneously assumed that it was petitioner's burden to show *lack* of independency, rather than respondent's burden to establish independency, stating:

> "The evidence does not support *plaintiff's* contention that the Bureau of Mines may have developed the '610' process after having been informed of the success of Allegheny Ludlum indirectly remelting ingots as ingots without intermediate fabrication between July 12 and July 23, 1952." (FF 29, Petn. 18a).

Obviousness on the basis of another's independent development is an affirmative defense, which a *defendant* must shoulder, not the plaintiff. *Russell* v. *Seeburg Corp.*, 123 F.2d 509, 512 (7th Cir. 1941).

The District Court's erroneous imposition of the burden on plaintiff was critical.

In any event, the District Court's conclusion of obviousness by reason of independent invention by the Bureau of Mines should first be reviewed by the Court of Appeals majority before any review here.*

---

* The majority below characterized this defense as "independent" of the holding of obviousness over the prior art. If it were indeed independent, the entire law of priority determination in patent interferences would be unnecessary, for the mere fact of near simultaneous independent invention would establish obviousness. Of course, it does not.

The Newly Asserted Defense of Anticipation, Not Previously Made to the District Court, Cannot Support Its Conclusion of Obviousness

The sole ground on which the patent in suit was found invalid was obviousness (Conc. G, Petn. 33a). There were express determinations of novelty (lack of anticipation by the prior art) by the District Court (FF 16, Conc. F, Petn. 14a, 33a). Nevertheless, respondent here seeks (R. Br. 4, 14-5) to justify the lower court's determination of invalidity on the basis of obviousness, by *contradicting* the court's express novelty determination with an unsupported argument that the patent was anticipated by an article (Sx, O, pp. 32-45) which was an exhibit introduced into evidence by pretrial stipulation but *never mentioned* by either party either at trial, or in post-trial briefing and argument.

As above pointed out, the statement quoted from the article (R. Br. 14) obviously deals with the identical technique described in Herres and Davis patent No. 2,541,764, the patent expressly considered by the CCPA with respect to the application for petitioner's patent, before reaching its conclusion of *un*obviousness (Petn. 11, 33a, 38a-42a).

It is not surprising that the District Court "overlooked" this article when it was not even mentioned by the parties. It *is* surprising that respondent would seek to advance it at this stage and thereby so cogently manifest its difficulty in supporting the lower court's "obvious to try" standard.

CONCLUSION

That the "obvious to try" standard was the basis of the majority conclusion below is evident. The conflict with the CCPA rejection of that standard, and the conflict with the CCPA decision of unobviousness of the invention in suit, are also evident. The conflict should be resolved by this Court in order that the courts below (and the Patent Office) may know whether the "obvious to try" standard should or should not be employed in satisfying the statutory requirement of consideration of obviousness.

EDWARD F. MCKIE, JR.
HAROLD J. BIRCH
WILLIAM E. SCHUYLER, JR.

Schuyler, Birch, Swindler,
McKie & Beckett
One Thousand Connecticut
Avenue, N.W.
Washington, D. C. 20036

Attorneys for Petitioner